

REMARKS

In view of the above amendments and following remarks, reconsideration of the rejections and further examination are requested. Upon entry of this amendment, claim 6 is added. No new matter has been added.

Examiner Interview

Applicants appreciate the interview granted by the Examiner. In the interview, the Examiner stated that if the claims were amended to recite that the endless member is configured to contact at least a center of the label, the claims would overcome the cited prior art. As noted above such subject matter has been added as dependent claim 6.

Rejections Under 35 U.S.C. §103(a)

Claims 1-5 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yuyama (JP 2001-130504) in view of Iijima (JP 57-175545). Claims 1 and 3-5 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kontz (US 4,851,072) in view of Iijima.

Applicants respectfully traverse this rejection and submit that the claims as currently pending are allowable over the cited prior art. Specifically, independent claim 1 recites a labeling apparatus, comprising an endless member that is configured and arranged such that each label is supplied between the endless member and the vial.

The prior art fails to disclose or render obvious such an apparatus. In particular, the Examiner recognizes that neither Yuyama nor Kontz discloses this subject matter. For this subject matter, the Examiner relies on Iijima. On page 2 of the Office Action, the Examiner states that Iijima discloses a holder 4 that presses the container 2 to the drum 1, and sticks a label 3 to the container. The Examiner also states that Iijima discloses a belt 42 that presses the container 2 to the drum. In light of this disclosure, the Examiner concludes that it would have been obvious that the belt comes into contact with the label. *See* pg. 2 of the October 29, 2010 Office Action.

Applicants respectfully disagree and note that nowhere in Iijima is such subject matter explicitly disclosed. Furthermore, there is no inherent disclosure of an endless member that is configured and arranged such that each label is supplied between the endless member and the

vial. At best, a label in Iijima may come in contact with belt 42. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); *see also* MPEP 2112. Therefore, Applicants submit that there is no explicit or inherent disclosure in Iijima of this subject matter.

Moreover, Applicants submit that it would not have been obvious to enable the belt 42 to contact the label, since there is no reasoning in the prior art to modify Iijima to enable such contact. With regard to the obviousness rejection, the Examiner merely makes the conclusory statement that "it would have been obvious that the belt (i.e. endless member) comes into contact with the label". Applicants submit that the Examiner is making a conclusory statement. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.* 82 USPQ2d 1385, 1396 (2007). Moreover, the Examiner has not provided any factual support to support the determination of obviousness. *See In re Warner*, 379 f.2d 1011, 1017 (CCPA 1967). Therefore, Applicants submit that the Examiner has not as established a *prima facie* case of obviousness as to why one of ordinary skill in the art would have modified Iijima to enable the belt 42 to contact the label.

Additionally, Iijima specifically discloses that the labels 3 sucked at a negative pressure and conveyed by the drum 1 are applied with glue by a glue applying mechanism 7. Thus, since Iijima discloses a manner to attach the label to the vial, there is no reasoning to modify Iijima to include an endless member that is configured and arranged such that each label is supplied between the endless member and the vial as required by claim 1 of the present invention.

Therefore Applicants submit that independent claim 1 and its dependent claims are allowable over the cited prior art.

Conclusion

In view of the foregoing amendments and remarks, all of the claims now pending in this application are believed to be in condition for allowance. Reconsideration and favorable action are respectfully solicited.

Should the Examiner believe there are any remaining issues that must be resolved before this application can be allowed, it is respectfully requested that the Examiner contact the undersigned by telephone in order to resolve such issues.

Respectfully submitted,

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/Jeffrey J. Howell/

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